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### Remarks

Reconsideration of the above referenced application in view of the enclosed remarks is requested. No claims are amended. Claims 1-5, 7-10, and 12-20 are now pending in the application.

### ARGUMENT

Claims 1-5, 7-10 and 12-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,694,335 to Hopmann et al. (hereinafter "Hopmann et al.") in view of U.S. Patent No. 6,658,463 to Dillon et al. (hereafter, "Dillon et al.") and further in view of U.S. Patent No. 6,226,650 to Mahajan et al. (hereinafter "Mahajan et al."). This rejection is respectfully traversed and Claims 1-5, 7-10 and 12-20 are believed allowable based on the following discussion.

Applicants maintain their arguments as presented in their previous response. Further, additional combination of the Mahajan et al. reference fails to show all of the elements of Applicants' claimed invention, as discussed below.

Specifically with regard to Claim 1, Applicants' cache device may store information from the user (portable device) until such time as the remote device becomes available. The remote device has access to a database which is typically too large to store on the portable device. For instance, a user may update large amounts of information to be synchronized with a database via the remote device, but the remote device may not always be available. Further, the user may desire to uncouple the portable wireless communication appliance from the cache device, i.e., take the portable device to another location, and enable the remote database to be updated as soon as the remote device becomes available. In some instances, the cache device is "always on" whether or not it is in communication with the portable device. Thus, updates may occur to/from the cache device even when the portable device is not in proximity to the cache device.

In general, the cited references, either alone or in combination, do not teach the claimed elements of Applicants' invention. None of the references teach managing a database where a predetermined portion of the database is stored on the cache-device where the cache-device is accessible to a portable device, where the portable device may cause an update to a remote

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database via a remote device while connected to the cache-device or that the update is delayed until the remote device becomes available. In the latter case, the portable device may no longer be connected the cache-device.

The Examiner misapplies the teachings of Dillon et al., as Dillon et al. teach a method for caching web pages for faster access to a user. Dillon et al. do not teach updating or managing a database based on information received from a user (via the portable device). It is improper of the Examiner to assert that the URLs are the same as a database, as claimed by Applicants. Dillon et al. teach that the proxy server caches a variety of web pages that may be related or unrelated. The cached web pages are cached only to provide quick access to them, so the server need not be queried every time. The only database taught by Dillon et al. seems to be a database of URLs that resides on the proxy server. This database is to store popular URL entries and associated domain data, etc. A remote device (server) does not have access to this database, nor is it to be used by a portable wireless device. This database is merely used to forward or download URLs and is not a database as described and claimed by Applicant. Therefore, the Examiner fails to show all of the features of the claims, even when combining the references.

Further, Hopmann et al. teach a device for synchronizing changes among multiple copies of data. Hopmann et al. teach that an identifier represents the current state of the data and the identifier is used to determine what, if any, changes have occurred to the data. Thus, instead of comparing the data itself to see if changes have been made, the identifier is used to simply and easily determine if changes were made to the data. The Examiner states that Hopmann et al. teach a *remote device with access to the database, the database residing remote to the portable wireless communication appliance*. However, the cited reference (Col. 9, lines 62-65 and col. 10, lines 28-36) do not show a database at all. Hopmann et al. merely teach that a client device may have data on it. This is not the same as a database as understood by one of skill in the art, and described in the specification. Nor do Hopmann et al. teach that the database resides remote to the portable wireless communication appliance.

The Examiner admits that Hopmann et al. do not disclose a cache device configured to *communicate wirelessly with the portable wireless communication appliance and to communicate with the remote device, the cache device storing a copy of a predetermined portion of the database*. The Examiner asserts that Dillon et al. teach this.

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Dillon et al. teach a multicast system to provide proxy servers having web page content to be retrieved by a web server. There is no user interaction to a portable device disclosed in Fig.4. The end point of the information is on the web server(s) 110. Cache misses are limited to the web server and require additional data download from the proxy servers. In contrast, Applicants' claimed invention allows a portable device to operate even when unconnected from the remote system having the database. Dillon et al. require the web servers to have access to the proxy servers and update information not held in cache, as necessary, when a cache miss occurs. Dillon et al. do not teach or suggest a system that will allow a user to continue to operate a portable device when unconnected to the remote device (server). Hopmann et al. teach a system for updating database changes, but do not teach or imply a system that will enable a portable device to operate even when the cache device is unconnected to the remote device (server).

The Examiner also admits that neither Dillon et al. nor Hopmann et al. disclose *wherein the remote device is configured to both send and retrieve database updates to and from the portable wireless communication appliance via the cache device*. The Examiner asserts that Mahajan et al. teach this at Col. 5, lines 36-51. In fact, Mahajan et al. teach a system for updating databases on computer systems of an intermittently connected database system. Mahajan et al. teach that a subset of data of the server database stored in a local database. (Col. 5, lines 39-40) In this context, the local database is stored on or in the computer 16 and cannot be decoupled from the computer. It is not stored on a separate device. Mahajan et al. also teach that when the subset of data is modified that the modifications are transmitted to the server database. Applicants' claimed invention does not store a subset of data in a local database as taught by Mahajan et al. Claim 1, for instance, requires *the cache device storing a copy of a predetermined portion of the database*. It will be apparent to one of ordinary skill in the art that the predetermined portion of the database is not stored locally. The portable device and cache device are coupled via a wireless communication device. It will be understood one of ordinary skill in the art that the portable device may be operated when it is not in proximity to the cache device for many purposes. For instance, a non-exhaustive list of example portable devices is described in the Background section as including personal digital assistants, radiotelephones, and laptop computers, and other devices equipped with computing and wireless communication features. It will be apparent to one of skill in the art that these types of devices are meant to be

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transported by a user for use away from the cache device. None of the references cited teach or disclose a system for operating a portable device in the following scenarios:

- portable device in proximity to the cache device,
  - where the cache device is in contact with the remote device database,
  - where the cache device is not in contact with the remote device database;and
- portable device not in proximity to the cache device.

Thus, combining the teachings of Dillon et al., Hopmann et al. and Mahajan et al. will not result in Applicants' claimed invention. Specifically, Claim 1 and its progeny are believed allowable.

Specifically, as for Claim 15, the Examiner asserts that Hopmann et al. teach *synchronizing a copy of a predetermined portion of a database stored in the cache device with the database communicatively coupled to the remote device according to the cache-device preferences prior to the unavailability of the remote device*. Hopmann et al. do not teach or suggest that a predetermined portion of a database is stored on a cache device. Hopmann et al. teach that a copy of some data is stored directly on the client and synchronized with the server. Hopmann et al. do not teach a cache device. This additional element must exist to provide the advantages of Applicants' invention, as discussed above and in the specification. Thus, the Examiner has failed to provide an appropriate reference for each element of Applicants' claimed invention. Thus, Claim 15 and its progeny are believed allowable. Further, as discussed in more detail below, there is no motivation in Hopmann et al. that would suggest that applying the web proxy servers of Dillon et al. would improve the monitoring the state of a collection of resources, which is the subject area taught by Hopmann et al.

As for Claims 5, 10 and 16, the claimed invention requires *a cache device storing a predetermined portion of the database*, where the cache device is in wireless communication with the portable device. Hopmann et al. do not teach or suggest that a predetermined portion of the database is stored on a cache device that, by definition of a portable device, may be intermittently connected to the portable device. The cited references show systems and methods for synchronizing databases and enabling faster download of web information using proxy servers. The cited references do not teach a portable device that may operate within or without

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proximity to a cache device, wherein the cache device operates to either pass database information from a remote device through to the portable device, or caches portions of data for the portable device to use when then the remote device is unavailable. Therefore, Claims 5, 10, 16 and their progeny are believed allowable.

The § 103 rejection of claims 1-5, 7-10 and 12-20 based on, Hopmann et al., Dillon et al. and Mahajan et al. is in error. As an initial matter, the Office action fails to identify a legally cognizable suggestion for combining Dillon et al., Hopmann et al. and Mahajan et al. In this regard, the Office action states: "Given the teaching of Dillon, it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Hopmann by including a proxy server between the client and server to provide information to client without having to communicate with the server in a timely and efficient manner." However, there is nothing in Hopmann et al. that suggests a proxy server would be a benefit or any other motivation for this combination. Further, Hopmann et al. teach a system for synchronizing changes among multiple copies of data. Dillon et al. teach a satellite communication system with an upstream proxy server and a downstream proxy server to multicast URLs (web pages) to speed delivery of URLs to a user and minimize cache misses. There is no suggestion in either Hopmann et al. or Dillon et al. that would motivate one to combine the references. Moreover, they do not even solve the same problem.

The Office action also states: "Given the teachings of Mahajan et al., it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Hopmann et al. in view of Dillon et al. by allowing the server to update and retrieve information from the client's cache in order to synchronize the server client databases, so that both databases contain the same information thereby providing updated information to the databases in a timely and efficient manner." The Examiner cites the result of "providing updated information to the databases in a timely and efficient manner." However, as a matter of law and fact, this is not a proper suggestion for combining the references, as it is not a suggestion or motivation found in one of the references. Moreover, combining the references would not result in Applicants' claimed invention, as discussed above, because the cited references do not show all of the limitations of the claimed invention.

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Turning to the legal error, Applicants wish to remind the Examiner of the bedrock legal principles for rejecting a claim under 35 U.S.C. § 103. Specifically, in *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) the Federal Circuit explained:

To reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness. In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.

*Id.* at 1455 (citations omitted and emphasis added).

In the Rouffet case, the Examiner had rejected the pending claims on a combination of references. The Board sustained the Examiner. However, the Federal Circuit reversed the Board's decision and ruled that the Examiner's rejections were legally impermissible because they failed to demonstrate a suggestion for combining the references in the manner proposed by the Examiner. As explained by the Federal Circuit:

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

*Id.* at 1457-58 (citations omitted and emphasis added). These principles have not been followed in rejecting Claims 1-5, 7-10 and 12-20. Merely stating an advantage or possible advantage of combining references, as was done to reject the claims, is not the same as "show[ing] a motivation to combine the references."

On the contrary, in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. In *re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In order to establish a *prima facie* case of unpatentability, particular factual findings demonstrating the suggestion to combine must

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be made. See, for example, Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1072-73 (Fed. Cir. 2000) and In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999). Indeed, the law is quite clear that an obviousness rejection must be based on facts, not conjecture.

The Supreme Court... foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness *must be supported by facts*. Where the legal conclusion is not supported by facts it cannot stand.

In re Warner, 379 F.2d 1011, 1017 (C.C.P.A. 1967). This longstanding principle has been followed to date. For example, in the unpublished Board decision, Ex parte Megens, App. No. 1999-0277 (B.P.A.I. Oct. 29, 1999), the Board stated:

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner's conclusion that it would have been obvious to incline Phillips' loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such accumulation would pose a problem even if it did occur. It is therefore apparent that the examiner has resorted to improper speculation and hindsight reconstruction to overcome the admitted deficiency of Phillips vis-à-vis the subject matter recited in claim 1.

(Megens at Pages 4-5) (emphasis added).

This is precisely the situation presented here. The "suggestion" in support of the rejection of Claims 1-5, 7-10 and 12-20 amounts to nothing more than a speculative statement that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would allegedly achieve, a person skilled in the art would have found it obvious to combine the references to create the claimed invention. The problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references from the obviousness analysis. More specifically, the analysis present in the Office action proceeds in the following manner:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?

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c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed in the Applicants' claims?

d) If so, combine the elements in the manner proposed by the Applicants and reject the pending claims.

This mode of analysis is, of course, deeply flawed. Specifically, as noted by the Federal Circuit in the Rouffet quote identified above, all of the elements of most claimed inventions can almost always be found in the prior art. Therefore, the answer to step "b" above will almost always be "yes". Since it is a statutory requirement that all inventions have utility, there will also always be an identifiable end or advantage in combining the elements in the prior art in the manner proposed by any claim (e.g., if there was no purpose to an element in a claim it would not be included in the claimed apparatus, after all, who would pursue a claim with superfluous elements or a claim with no utility?). Therefore, if the "suggestion" requirement of 35 U.S.C. § 103 can be met by merely identifying any end or advantage which will be achieved by combining the elements of the prior art references, the suggestion requirement can always be met and is utterly meaningless.

This inherent flaw in the analysis employed in rejecting Claims 1-5, 7-10 and 12-20 is elucidated by viewing the alleged "suggestion" the Office action identifies in support of the rejection. As noted above, in rejecting the claims, the Office action states: "it would have been obvious for one having ordinary skill in the art at the time of the invention to modify the references to add elements of the other references. The first part of the statement, namely, "It would have been obvious ... to modify" is merely boilerplate language that does not address the suggestion requirement. The second part of the statement, namely, "it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Hopmann et al. with Dillon et al. to provide information to client without having to communicate with the server in a timely and efficient manner and then to modify this with Mahajan et al. in order to synchronize the server client databases so that both databases contain the same information/data thereby providing updated information to the databases in a timely and efficient manner, simply states what the proposed modification of the primary reference is to be. This second part of the Examiner's statement, thus, describes the proposed modification, but offers no explanation of a



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motivation for making that modification. The final part of the statement, namely, "in order to provide information to client without having to communicate with the server in a timely and efficient manner" and "in order to synchronize the server and client databases so they both contain the same information..." must, then be the alleged "motivation" for modifying Hopmann et al. Further, being "timely and efficient" is not the specific goal of Applicants' invention. Applicants' invention allows a user with a portable device to operate on a database while connected or disconnected from a remote database by way of a cache device. The cache device may update its own local database from the server in order to allow the portable device to operate on the database when there is no connection. "Timely and efficient" don't even enter into the picture. Operating in a portable and selectively disconnected state are more applicable motivations, but these are not taught or suggested by the references, either. Applicants' invention claims a communication path that doesn't even exist in the cited references, i.e., portable device to cache device (connected and disconnected) to a remote database.

However, while it is true that one possible advantage of a client-server system is the advantage of adding a cache device, as described by Applicants, that is not a suggestion in and of itself for using a proxy server and data update (send/retrieve) mechanism. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992) (emphasis added). Here, the Office action does not identify any evidence in the prior art indicating or in any way suggesting the desirability of the proposed modification. It only identifies an old element that has an inherent property. Indeed, the Office action's naked, conclusory statement amounts to nothing more than stating that a person of ordinary skill in the art would be motivated to modify Hopmann et al. with Dillon et al. and then Mahajan et al. because they would want to gain a benefits from doing so. Of course, such circular reasoning (i.e., add "X" to have "X") cannot be a legally proper tool for identifying a suggestion for combining references. If it were, no combination of old elements would ever be patentable since one can always nakedly state, a person would be motivated to add old element X from one reference to another reference because adding element X offers an advantage (again, if adding "X" had no advantage, who would ever claim it?). Simply put, there

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is *always* an advantage to combining old elements that can be identified through hindsight *once that combination is known*.

It should be quite clear from the above that merely identifying an advantage for adding an old element to a combination of elements is not a proper suggestion for making that combination. The MPEP further proves this point. In particular, MPEP § 2144 states that “the strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent, that some advantage would have been produced by their combination.” The MPEP cites In re Sernaker, 702 F.2d 989, 994-95 (Fed. Cir. 1983) to support this proposition.

Looking at the Sernaker case, we see that the Federal Circuit states: “The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings.” Sernaker, 702 F.2d at 995-96 (emphasis added). Notice that this statement does not state that it is obvious to combine references simply because there is an advantage to doing so. On the contrary, it carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion, but rather the Court makes it clear that something else suggests the advantage.

The MPEP quote noted above is similar. It states that the “strongest rationale for combining references is a recognition... in the prior art or... based on established scientific principles or legal precedent that some advantage or expected beneficial result would have been produced by their combination.” (MPEP, Page 2100-127) (emphasis added). This, of course, does not state that the strongest rationale for combining references is the mere presence of an advantage to doing so. Instead, as in Sernaker, the strongest rationale is a recognition (i.e., a suggestion) in the art that an advantage will result.

Turning back to the rejections at issue, rather than identifying something in the art that suggests an advantage to making the combination, the Office action just looks for the advantage itself and mislabels that advantage as “suggestion.” As explained above, this is a *literal*

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elimination<sup>1</sup> of the suggestion requirement. Since there is always an advantage to a claimed element (or why would you claim it?), the Office action's misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis. Clearly, neither the MPEP section noted above nor the Sernaker case upon which that MPEP section rests for authority stands for the proposition that an advantage of an element is a suggestion in and of itself for including that element in a combination.

In view of the foregoing, applicants respectfully submit that the § 103 rejection of Claims 1-5, 7-10 and 12-20 must be withdrawn because it fails to identify a legally proper suggestion for combining the prior art references in the manner proposed by the Office action. In other words, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. On this basis alone, the rejections of 1-5, 7-10 and 12-20 must be withdrawn.

Thus, all of the pending claims are believed allowable.

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<sup>1</sup> It literally removes the "recognition" portion of the MPEP quote above and the "something in the art" portion of the Sernaker quote.

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### CONCLUSION

In view of the foregoing, Claims 1-5, 7-10, and 12-20 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (703) 633-6845. Early issuance of Notice of Allowance is respectfully requested. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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